

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

United States Patent No. 5,784,808

Issued: 28 July 1998

Inventor: Stan Hockerson, a U.S. citizen, of Albuquerque, NM

Assignee: HOCKERSON-HALBERSTADT, INC. (a Louisiana corporation)

FOR: "Independent impact suspension athletic shoe"

ATTORNEY DOCKET NO.: A09027US (99413.1)

**Declaration of John P. Halberstadt**

I am the secretary/treasurer of the assignee of the above-referenced patent.

I was christened Johan Philip Halberstadt as a baby in South Africa, but my U.S. passport is in the name of John Philip Halberstadt. My earlier U.S. patents list me as Johan P. Halberstadt, while my latest patent application lists me as John P. Halberstadt.

Stan Hockerson and I have been partners in business since around 1991, when we formed Hockerson-Halberstadt, Inc. We together have seven issued patents (some in my name, some in Stan's name, and some assigned to Hockerson-Halberstadt, Inc., as detailed in the table set out below). We have always paid the maintenance fees in these patents. Since around 1991 Richard Backus has handled our patent work. Richard Backus has always timely sent us reminders of the maintenance fees due (except for the second maintenance fee due in United States Patent No. 5,784,808). We have issued over 70 licenses of our patent rights, and we have received millions of dollars licensing our patent rights. We would never knowingly allow one of our patents to lapse for failure to pay a maintenance fee.

I understood that Richard Backus would send us a reminder regarding future maintenance

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fees, as Richard Backus has represented us in patent matters since around 1991 (he has handled patents, a reexamination proceeding, and an appeal in the Court of Appeals for the Federal Circuit related to Hockerson-Halberstadt, Inc. patents). He has obtained several patents for me and Stan Hockerson, and he has handled the maintenance fees for me, Stan Hockerson, and Hockerson-Halberstadt, Inc. In the over 17 years since Richard Backus first represented us, he has always timely informed us or reminded us of deadlines, except for renewal reminders in relation to the 8-year maintenance fee of United States Patent No. 5,784,808.

Unfortunately, we never received any renewal reminders in relation to the 8-year maintenance fee of United States Patent No. 5,784,808 from Richard Backus.

I have since learned (on or about 18 November 2008, when I received an answer to a complaint in a lawsuit filed by Hockerson-Halberstadt, Inc. and Standon LLC against New Balance Athletic Shoe, Inc. asserting infringement of United States Patent No. 5,784,808) that the above-referenced patent lapsed on 28 July 2006 for failure to pay the 8-year maintenance fee.

Patent attorneys have been engaged on behalf of Hockerson-Halberstadt, Inc. to investigate what happened and whether the patent could be revived. After much investigation it appears that the reason we did not receive a renewal reminder is that there was a docketing error which caused reminders about United States Patent No. 5,784,808 to be removed from Richard Backus's docket system, apparently sometime after the payment of the first maintenance fee in that patent.

We did not deliberately allow United States Patent No. 5,784,808 to lapse. The lapsing

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of United States Patent No. 5,784,808 was unintentional and unavoidable. We understood that Richard Backus, who we had engaged to handle our patent matters and as of 28 July 2006 had represented us for about 15 years in patent matters, would timely remind us of due dates for the 8-year and 12-year maintenance fees in United States Patent No. 5,784,808, as he had for the 4-year maintenance fee.

We did not deliberately delay in paying the 8-year maintenance fee. Since we learned of the failure to timely pay the fee, we have worked to determine whether the fee could be paid late and what steps must be taken to pay the fee late. We would like for the 8-year maintenance fee to be accepted at this time.

With regards to this matter, Stan Hockerson has handled most of it on our behalf. We communicate regularly by phone at least once, usually twice, a week and he has kept me in the loop via additional telephone calls whenever there has been news or a new development. In addition, I have been copied on communications from attorneys to Stan Hockerson concerning the case. I have also corresponded directly with our attorneys.

On or about 21 November 2008, I went online to the USPTO website and confirmed that United States Patent No. 5,784,808 had apparently lapsed.

At around the same time I obtained information concerning maintenance fees and possible reinstatement procedures.

When going through accounting records on or around 8 December 2008, I found a payment to Richard Backus dated 4/2/05 that seemed to be applicable.

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On or about 10 December 2008, I managed to obtain a copy of the check (attached hereto as Exhibit A) from the bank and e-mailed it to Don Nauman (one of our attorneys) and Stan Hockerson. It later turned out to be for the maintenance fee for my U.S. Patent No. 5,678,327, which was correctly submitted to the USPTO by Richard Backus on my behalf. This took place around about the same time period that I understand Mr. Backus would have had to submit maintenance fees for Stan Hockerson's United States Patent No. 5,784,808 (which indicates to me Mr. Backus's normal diligence in these matters).

In the interim period Stan Hockerson did the legwork with our attorneys regarding seeking reinstatement.

Stan Hockerson and I had a very good business relationship and friendship with Mr. Backus over many years. He did an outstanding job for us and we felt we could always rely on his professionalism, competence and diligence ... there was only this one glitch (the failure to pay the second maintenance fee in United States Patent No. 5,784,808).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent.

John P. Halberstadt  
1707 Hemlock Way

  
Date

3/2/09

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Broomfield, CO 80020  
Tel: 303-439-9291

**Patents of Stan Hockerson and Johan Halberstadt (with current status):**

<b>GSNN Ref. No. Application No. Filing Date Inventor (Assignee of record)</b>	<b>Patent No. Issue Date Expiration Date</b>	<b>Title Publication No.</b>	<b>Maintenance fees/ due</b>
99413.5 10/909,972 3 August 2004 Stan Hockerson	7,111,415 26 September 2006 17 February 2024	Athletic shoe frame  US 2005/0198863	26 March 2010, 2014, 2018 CIP of 10/714,546, filed 14 November 2003 Term ext by 93 days
99413.4 09/402,746 12 October 1999 Stan Hockerson, Thomas C. Lynch	6,273,827 14 August 2001 12 October 2021	Golf putter head	14 Feb. 2005 (paid 14 Feb. 2005), 2009 (paid 13 Feb. 2009), 2013
99413.3 09/308,050 11 May 1999 Stan Hockerson	6,145,221 14 November 2000 11 May 2019	Cleated athletic shoe	14 May 2004 (paid 14 Jan 2004), 2008 (paid 12 Dec 2007), 2012

99413.1 08/714,964 17 September 1996 Stan Hockerson (Hockerson- Halberstadt, Inc.)	5,784,808 28 July 1998 1 March 2013	Independent impact suspension athletic shoe	(currently lapsed - working on reviving) 28 January 2002 (paid 18 Jan 2002), 2006 (not paid), 2010  fee was due 28 July 2006 with 6 month grace period - next due 28 January 2010  Cont of 400,336, filed 8 March 1995; which is a CIP of 259,744, filed 14 June 1994; which is a Cont of 24,601, filed 1 March 1993
99413.2 08/524,726 6 September 1995 Johan Halberstadt	5,678,327 21 October 1997 21 July 2014	Shoe with gait- adapting cushioning mechanism	All Mfees paid 21 April 2001 (paid 16 May 2001), 2005 (paid 7 April 2005), 2009 (paid 16 Feb. 2009)  CIP of 260,718, filed 21 July 1994
99413.1 06/101,708 10 December 1979 Stan Hockerson (Hockerson- Halberstadt, Inc.)	4,322,895 6 April 1982 10 December 1999	Stabilized athletic shoe	expired (all Mfees paid)

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99413.1 06/061,427 27 July 1979 Johan Halberstadt (Hockerson- Halberstadt, Inc.)	4,259,792 7 April 1981 27 July 1999	Article of outer footwear	expired (all Mfees paid)
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Exhibit A - Halberstadt Declaration

<b>HEART AND SOLE USA LLC</b> 1707 HEMLOCK WAY BROOMFIELD, CO 80020		<b>1030</b> 82-600/1070
Pay to the order of <u>Richard E. Backus</u>		<u>4/2/05</u>
One thousand three hundred fifty only / <u>00</u>		\$ <u>1,350.00</u>
<b>Heritage Bank</b> <small>5720 W. 120th Avenue - (303) 440-0111          Broomfield, Colorado 80020          24-Hour Bank Line (303) 296-4434</small>		Security Features Deposit as Cash
<u>For Maintenance Fees</u>		<u>J. Halberstadt</u>
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04112365 1020-00199 ENT-2255 TRC-2266 PK-13 0525181900	APR - 7 05	012100035843 E1507 355 SF CA 253 04/07/05 0525181900	08596
04-11-05 201 315	00005003837-29 12100358	1030	
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By the Bank of America  
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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**STATEMENT UNDER 37 CFR 3.73(b)**Applicant/Patent Owner: Stan Hockerson/Hockerson-Halberstadt, Inc.Application No./Patent No.: 5,784,808Filed/Issue Date: 28 July 1998

Titled:

Independent impact suspension athletic shoeHOCKERSON-HALBERSTADT, INC., a corporation

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest in;
2. ☐ an assignee of less than the entire right, title, and interest in  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_ %); or
3. ☐ the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)

the patent application/patent identified above, by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 020045, Frame 0124, or for which a copy therefore is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at

Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at

Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at

Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet(s).

- ☐ As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

/Seth M. Nehrbass, #31,281/

Signature

26 February 2009

Date

Seth M. Nehrbass

Printed or Typed Name

Patent Attorney

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.